

REMARKS

Summary of the Office Action

In the Office Action, claims 1-11, 16, 18-21, and 31-33 stand rejected under 35 U.S.C. §103(b) as allegedly being unpatentable over U.S. Patent No. 5,554,094 to *Viens*.

Applicant respectfully traverses these rejections and objections for the following reasons.

Summary of the Response to the Office Action

Applicant amends independent claims 1, 16, and 33 to clarify the invention and adds claims 34 and 35 to provide an alternate scope of protection. Accordingly, claims 1-11, 16, 18-21, and 31-35 are pending for further consideration.

All Subject Matter Complies with 35 U.S.C. § 103(a)

Claims 1-11, 16, and 18-21 stand rejected under 35 U.S.C. § 103(a) as obvious over *Viens*. Applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness and therefore all rejections under 35 U.S.C. § 103(a) should be withdrawn.

To establish a *prima facie* case of obviousness, three basic criteria must be met (see MPEP §§ 2142-2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations. All three criteria must be met to establish obviousness.

The Office Action has not established a *prima facie* case of obviousness at least because *Viens* does not teach or suggest all the recited features of newly amended independent claims 1 and 16. Namely, *Viens* does not teach or suggest at least the “a folding mode . . . wherein one of

a plurality of folding modes can be applied on the sheet as the sheet proceeds along a single sheet path," features recited in claims 1, 16, and 33.

Viens discloses three separate sheet folding apparatus 12 that have different folding sheet paths. Each sheet folding apparatus 12 can be exchanged to perform Z-folding, C-folding, and half-folding of sheets. The different sheet paths are shown in Figs. 5A-5B, 6A-6B, and 7A-7B, respectively. The sheet folding apparatus 12, and hence their sheet paths, are manually exchanged from one to another. See col. 1, lines 65-67; col. 6, lines 29-35; and col. 8, lines 48-52 of *Viens*. Thus, *Viens* teaches away from the present invention because *Viens* discloses sheet folding apparatus 12 with different sheet paths that must be manually exchanged to enable the Z-folding, C-folding, and half-folding of sheets. See col. 5, line 9 through col. 8, line 30 and Figs. 5A-5B, 6A-6B, and 7A-7B of *Viens*.

In the present invention, the letter Z-folding, letter C-folding, and Z-folding of sheets requires only a single configured sheet path. See at least page 12, lines 21-24 of the specification. All three types of sheet folding can be accomplished with one single sheet path configuration as seen in Fig. 3 of the specification. No alternate sheet paths are necessary and no exchange of parts is needed to accommodate the different folding modes of the present invention.

Further, the Office Action does not establish a *prima facie* case of obviousness at least because it has not identified any suggestion or motivation to combine the cited reference with some level of skill in the art as cited in the Office Action. Similar to the cassette folder, tucker plate, and standard buckle plate devices discussed in the background section of *Viens*, *Viens* discloses a modified buckle plate. The Office Action, however, has not identified anything in

Viens that teaches or suggests the present invention.

The Office Action admits that “a folding mode selecting device” is not disclosed, but states that “one having ordinary skill in the art at the time the invention was made . . . [would] . . . have modified *Vien’s* [sic] sheet folding apparatus by having a folding mode selecting device . . . to easily switch from one mode to another without using hand’s [sic] power.” Applicant respectfully submits that the Office Action has provided no motivation or reason for a person skilled in the art to make the necessary changes in *Viens* to successfully create the present invention. As such, Applicant submits that the Office Action is using impermissible hindsight to arrive at the present invention.

“The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).” See MPEP § 2143.01. The Office Action does not provide any citation that shows the desirability of modifying *Viens*. The mere assertion that *Viens* could be modified is not sufficient by itself to establish *prima facie* obviousness. Therefore, it is respectfully submitted that the Office Action has not met the second prong of *prima facie* obviousness.

Third, the Office Action has not established a *prima facie* case of obviousness at least because *Viens*, whether alone or in combination, does not teach or suggest all the recited features of newly amended independent claims 1 and 16. Namely, *Viens* does not teach or suggest at least “a folding mode . . . wherein one of a plurality of folding modes can be applied on the sheet as the sheet proceeds along a single sheet path,” features recited in claims 1, 16, and 33.

As pointed out in M.P.E.P. § 2143.03, “[t]o establish *prima facie* obviousness of a

claimed invention, all the claimed limitations must be taught or suggested by the prior art". *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). Therefore, Applicant respectfully asserts that the third prong of *prima facie* obviousness has not been met.

Applicant respectfully asserts that newly amended independent claims 1, 16, and 33 are distinguishable over the applied art and that the rejections under 35 U.S.C. § 103(a) should be withdrawn. Additionally, claims 2-11, 18-21, and 31-32, which depend from independent claims 1 and 16, are allowable at least because their base claims are allowable, as well as for the additional features recited therein.

Moreover, independent claim 33 recites a combination features including "a folding mode selecting devise." As previously argued, the Office Action admits that "a folding mode selecting device" is not disclosed. Thus, Applicant respectfully submits that claim 33 is allowable for at least the same reasons articulated for independent claims 1 and 16.

New claims 34 and 35 are added to provide an alternative scope of protection. Applicant respectfully submits that they are allowable as written.

CONCLUSION

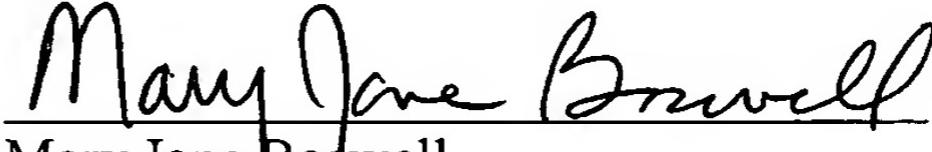
In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the Response, the Examiner is invited to contact the Applicant's undersigned representative to expedite prosecution.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

By:


Mary Jane Boswell
Reg. No. 33,652

Dated: April 12, 2005

Customer No. 009629
MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Avenue, N.W.
Washington, DC 20004
Tel: 202-739-3000